



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.                     | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/737,046                          | 12/16/2003  | Michael S. Hibbs     | BUR920010135US2     | 4755             |
| 23550                               | 7590        | 07/25/2005           | EXAMINER            |                  |
| HOFFMAN WARNICK & D'ALESSANDRO, LLC |             |                      | NGUYEN, HUNG        |                  |
| 75 STATE STREET                     |             |                      | ART UNIT            |                  |
| 14TH FL                             |             |                      | PAPER NUMBER        |                  |
| ALBANY, NY 12207                    |             |                      | 2851                |                  |

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

HA

## Office Action Summary

Application No.

10/737,046

Applicant(s)

HIBBS, MICHAEL S.

Examiner

Hung Henry V. Nguyen

Art Unit

2851

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 6/1/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-25, 27-37, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-25, 27-37, 39 and 40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/16/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 1, 2005 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21-25, 27-29 and 32-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 21, 32-33, the recitation of “wherein *the pressure difference* is controlled...sensor” is ambiguous since the claims do not define clearly “the pressure difference” between what regions. Therefore, “the pressure different” lacks proper antecedent basis in the claims.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

Art Unit: 2851

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 21-29 are rejected under the judicially created doctrine of double patenting over claims 1-7 of U. S. Patent No. 6,731,378 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: "a mounting structure"; "a pressure regulator", "a velocity sensor" (see claim 21 for example). In other words, instant claims 21-29 are merely re-written/or broader versions of claims 1-7 of U.S.Pat. 6,731,378.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2851

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 30-31, 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al (U.S.Pat. 6,710,845) in view of Buckley Jr (U.S.Pat. 4,245,862).

With respect to claims 30-31, 34-40, Wu et al (figures 2- 3) discloses a mounting system and a corresponding method for a pellicle comprising substantially all basic structures set forth in the instant claims such as: a mounting structure (230/wall 310) for coupling a pellicle (225) to a mask (235) wherein a sealed interior portion (240) is formed between the pellicle, the mask and the mounting structure (see figure 2 and col.6, lines 49-59) and a pressure regulator (320) in communication with the sealed interior portion to control a pressure in the interior portion wherein the pressure regulator (320) is coupled to a device (370) for measuring the pressure in the interior portion (see col.7, lines 38-40). Wu et al further disclose a calibrated leak from the interior portion to an exterior portion (see col.6, lines 63 thru col.7, line 8) and the pressure regulator communicates with the sealed interior portion through a port (340/345) in the mounting structure. Wu lacks to show an aerodynamic fairing adjacent the mask for reducing aerodynamic drag on the pellicle. However, this structure used on a movable object for the same purpose is well known per se. For example, Buckley shows an aerodynamic fairing (50) having a portion (53) that is coplanar with a trailer (51') and a curved taper extending from the portion of the roof of the tractor to reduce aerodynamic drag on the trailer (see figure 1). In view of such teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Wu et al and Buckley to obtain the invention as specified in the above mentioned claims of the present invention. It would have been obvious to a skilled

Art Unit: 2851

artisan to employ an aerodynamic fairing as taught by Buckley onto the mounting system of Wu. The purpose of doing so would have been to reduce the deformation of the pellicle due to the effects of the air turbulence when the mask is moving whereby the operation life of the device is greatly prolonged.

***Allowable Subject Matter***

8. Claims 21-25, 27-29 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
9. Claims 32 and 33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
10. The following is a statement of reasons for the indication of allowable subject matter: while the prior art of record teaches a mounting system for a pellicle and corresponding system wherein the pressure inside a sealed interior portion formed between the pellicle, the mask and the mounting structure is controlled based on a reading from a pressure sensor to maintain the flat surface on the pellicle but does not specifically disclose the pressure being controlled based on a reading of a position sensor or velocity sensor, as recited in the instant claims of the present invention.

***Prior Art Made of Record***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2851

Servais et al (U.S.Pat. 3,945,677) is cited for its teachings of an aerodynamic fairing.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Henry V. Nguyen whose telephone number is 571-272-

2124. The examiner can normally be reached on Monday-Friday (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Hung Henry V Nguyen**  
**Primary Examiner**  
**Art Unit 2851**

hvn  
7/15/05